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| 10/805,739 | 03/22/2004 | Kent F. Hayes JR. | RSW920030234US1 | 9574 |
| 23550 7590 03/07/2008 HOFFMAN WARNICK & D'ALESSANDRO, LLC 75 STATE STREET 14TH FLOOR ALBANY, NY 12207 | | | EXAMINER NGUYEN, VAN H | |
| | | | ART UNIT 2194 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOCommunications@hwdpatents.com

Office Action Summary

Application No.

10/805,739

Applicant(s)

HAYES, KENT .F.

Examiner

VAN H. NGUYEN

Art Unit

2194

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This communication is responsive to the amendment filed 12/10/2007.

Claims 1-31 are currently pending in this application.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 21-31 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to a signal directly or indirectly by claiming a medium and the Specification recites evidence where the medium is defined as "*transmission media*". In that event, the claims are directed to a form of energy which at present the office feels does not fall into a category of invention.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-31 are provisionally rejected on the ground of nonstatutory double patenting over claims 1-40 of copending Application No. 10/805963; and over claims 1-32 copending Application No. 10/78752.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on the copending applications since the referenced copending applications and the instant application are claiming common subject matter, if not identical subject matter.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending applications. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6-14, 17-23, and 25-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Mitchell et al.** (US 20040117494 A1) in view of **Campbell et al.** (US 20050188315 A1)

As to claim 1:

Mitchell teaches a tunable prerequisite resolution engine for client devices in an Open Service Gateway Initiative (OSGi) framework, comprising: a processor; and a memory (see ¶¶ 0026-0033), the memory including: a prerequisite computation system for determining, on a server, necessary prerequisites for one or more OSGi bundle(s) to be run on a client device; a bundle identification system for identifying possible combinations of OSGi bundles on the server that fulfill any of the necessary prerequisites that are lacking from the client device; a data access system for accessing a configuration corresponding to the client device, wherein the configuration sets forth computer resource types, and corresponding normalization factors and importance factors for the client

device (see the Abstract; the OSGi framework and OSGi bundles discussion; ¶¶ 0011-0012 and 0018-0052; see also, Figs. 1-5).

Mitchell, however, does not specifically teach a bundle selection system for selecting a final combination of OSGi bundles from the possible combinations of OSGi bundles by processing the configuration and computing based on amounts of the computer resources needed by each of the possible combinations of OSGi bundles.

Campbell teaches a bundle selection system for selecting a final combination of OSGi bundles from the possible combinations of OSGi bundles by processing the configuration and computing based on amounts of the computer resources needed by each of the possible combinations of OSGi bundles (see ¶¶ 0059-0069).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mitchell with Campbell because Campbell's teaching would have created a communication framework in which applications that directly or indirectly use the data delivered to or from the computing platform that is uncoupled from the particular communications management technique to allow reduce the cost and complexity of adding and modifying applications and of updating the communications management technique.

As to claim 2:

Mitchell teaches a communication system for communicating the prerequisites from the server to the client device, and for receiving a response from the client device, wherein the response identifies any of the necessary prerequisites that are lacking from the client device (*see the Abstract; ¶¶ 0011 and 0024-0030; see also, Figs.1-5*).

As to claim 3:

Mitchell teaches the configuration is accessed from among a group of properties files, and wherein each of the group of properties files is configured for a particular different client device (*see ¶¶ 0024-0040; see also, Figs.1-5*).

As to claim 5:

Mitchell teaches the computer resources types are *selected from the group consisting of* a bundle storage requirement, a new space size, an old space size, an open file quantity, a quota, a memory requirement, a socket quantity, and a thread quantity (*see ¶¶ 0033-0039; see also, Figs.1-5*).

As to claim 6:

Mitchell teaches a configuration system for setting the configuration for the client device (*see ¶¶ 0026-0029; see also, Figs.1-5*).

As to claim 7:

Mitchell teaches the prerequisites comprise *at least one of* a service and/or package (see ¶¶ 0023-0026; *see also, Figs. 1-5*).

As to claim 8:

Mitchell teaches the client device comprises: an analysis system for determining whether any of the necessary prerequisites are lacking from the client device; and a response system for generating and sending a respond to the server (see ¶¶ 0022-0030; *see also, Figs. 1-5*).

As to claim 9:

Mitchell teaches the client device communicates with the server over the Internet (see ¶0022).

As to claim 10:

Mitchell teaches the configuration sets forth computer resource types, and corresponding normalization factors and importance factors for a particular type of client device (see ¶¶ 0022-0030; *see also, Figs. 1-5*).

As to claim 11:

Mitchell teaches the configuration sets forth computer resource types, and corresponding normalization factors and importance factors for a group of client devices (*see* ¶¶ 0022-0030; *see also*, Figs.1-5).

As to claim 12:

Refer to the discussion of claim 1 above for rejection.

As to claim 13:

Mitchell teaches querying the client device to determine if the client device has the necessary prerequisites; and receiving a response from the client device that identifies any of the necessary prerequisites that are lacking on the client device, prior to the determining step (*see the Abstract*; ¶¶ 0011 and 0024-0030; *see also*, Figs.1-5).

As to claim 14:

Mitchell teaches caching the response on the server (*see* ¶¶ 0021-0022).

As to claim 17:

Mitchell teaches the configuration is accessed from among a group of properties files, and wherein each of the group of properties files is configured for a specific client device (*see* ¶¶ 0024-0040; *see also*, Figs.1-5).

As to claims 18 and 19:

Refer to claims 5 and 7 above, respectively, for rejections.

As to claim 20:

Mitchell teaches the method is performed recursively (*see ¶¶ 0018-0052; see also, Figs. 1-5*).

As to claims 21-23 and 25-31:

Refer to claims 1-4 and 5-11 above, respectively, for rejections.

Indication of Allowable Subject Matter

5. Claims 4, 15, 16, and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims subject to the 101, the double patenting rejections set forth above and subject to a final search.

Response to Arguments

6. Applicant's arguments filed 12/10/2007 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. The prior art made of record, see PTO 892, and not relied upon is considered pertinent to applicant's disclosure. Applicant should review these references carefully before responding to this office action.

Contact Information

8. Any inquiry or a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: (571) 272-2100.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VAN H. NGUYEN whose telephone number is (571) 272-3765. The examiner can normally be reached on Monday-Thursday from 8:30AM 6:00PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WILLIAM THOMSON can be reached at (571) 272-3718.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



VAN H. NGUYEN
PRIMARY EXAMINER